

REMARKS

In the January 27, 2005 Office Action, claims 1-20 stand rejected in view of prior art. No other objections or rejections were made in the Office Action.

Status of Claims and Amendments

In response to the January 27, 2005 Office Action, Applicant has amended the claims as indicated above. Thus, claims 1-20 are pending, with claims 1, 2 and 16 being the only independent claims. Reexamination and reconsideration of the pending claims are respectfully requested in view of above amendments and the following comments.

Drawings

In paragraph 1 of the Office Action, the Office Action indicates that the proposed drawing corrections filed on December 3, 2004 have been approved. Applicant wishes to thank the Examiner for approval of the proposed drawing corrections.

Rejections - 35 U.S.C. § 103

In paragraphs 3-6 of the Office Action, claims 1-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 1,722,855 (Owen et al) in view U.S. Patent No. 6,024,413 (Dixon et al) and further in view of one or more of U.S. Patent No. 6,443,533 (Lacombe et al) and U.S. Patent No. 416,190 (Terry). In response, Applicant has amended independent claims 1, 2 and 16 as mentioned above.

More specifically, independent claims 1, 2 and 16 now clearly recite, *inter alia*, that each of the reinforcement members is a one-piece unitary member that has inner threads that are configured to directly couple a threaded end of a spoke. Independent claims 1, 2 and 16, further recite that each of the reinforcement members do not have a cylindrical projection extending from the exterior surface in an inner radial direction. This arrangement is *not* disclosed or suggested by the Owen et al and Dixon et al patents or any other prior art of record. It is well settled in U.S. patent law that the mere fact that the prior art can be

modified does **not** make the modification obvious, unless the prior art *suggests* the desirability of the modification. Accordingly, the prior art of record lacks any suggestion or expectation of success for combining the patents to create the Applicant's unique bicycle rim.

Owen et al discloses a wheel with flanged reinforcing ferrules c. The reinforcing ferrules c have cylindrical projections k. The spokes a are secured to the reinforcing ferrules c by a spigot, which extends into the tubular spoke a.

In contrast, independent claims 1, 2 and 16 have reinforcement members without cylindrical projections extending from the exterior facing surface in an inner radial direction. Furthermore, the claims 1, 2 and 16 have reinforcement members with inner threads configured to directly couple a threaded end of a spoke.

Dixon et al does not remedy the deficiencies of Owen et al in that a plurality of reinforcement members with inner threads is not disclosed. Moreover, Dixon et al shows cylindrical protrusions 43.

Lacombe et al does not remedy the deficiencies of Owen et al and Dixon et al in that a plurality of reinforcement members is not disclosed.

Likewise, Terry does not remedy the deficiencies of Owen et al, Dixon et al and Lacombe et al in that a one-piece, unitary member is not disclosed. Furthermore, Terry shows a cylindrical protrusion e in Figure 1. Moreover, Terry relies on a solid, wooden felly H to form cavity G and space g to limit the movement of the spoke head E. The hollow, metal rim of Owen et al, Dixon et al or Lacombe et al is so different from the solid, wooden felly of Terry that one of skill in the art would not selectively combine the dissimilar devices.

Applicant respectfully submits that if the rim of the combination was somehow modified to meet the claims of the present invention, it would require a complete

reconstruction of the devices of the combination, which would destroy the teachings of the references.

Moreover, Applicant believes that the dependent claims are also allowable over the prior art of record in that they depend from independent claims 1, 2 and 16, and therefore are allowable for the reasons stated above. Also, the dependent claims are further allowable because they include additional limitations. Thus, Applicant believes that since the prior art of record does not disclose or suggest the invention as set forth in independent claim 1, the prior art of record also fails to disclose or suggest the inventions as set forth in the dependent claims.

Therefore, Applicant respectfully requests that this rejection be withdrawn in view of the above comments and amendments.

Double Patenting

In paragraph 8 of the Office Action, claims 1, 4, 14, 16 and 17 stand rejected under obviousness-type double patenting as being unpatentable over claims 1, 2, 6, 17 and 18 of application No. 10/430,396. A terminal disclaimer is filed herewith to remove the rejection.

Prior Art Citation

In the Office Action, additional prior art references were made of record. Applicant believes that these references do not render the claimed invention obvious.

Conclusion

In view of the foregoing amendment and comments, Applicant respectfully asserts that claims 1-20 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested.

Respectfully submitted,


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